

REMARKS

Claims 67-71, 73, 74, 76-80, 82-84, 92, and 94-96 were pending in the application. By this amendment, claims 67, 92, and 95 have been amended. No claims have been cancelled or added. Accordingly, claims 67-71, 73, 74, 76-80, 82-84, 92, and 94-96 remain pending. Reexamination and reconsideration of the claims as amended are respectfully requested.

Without acceding to any of the grounds for rejection set forth in the Office Action, Applicants respond as follows:

I. Rejections Under 35 U.S.C. § 112

Claim 95 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite due to lack of antecedent basis for the term “said member” in line 1 of the claim. Claim 95 has been amended to correct the error and to reconcile the terms used in claim 95 and its independent claim, claim 67. Applicants request withdrawal of the rejection.

II. Rejections Under 35 U.S.C. § 102

Claims 67-71, 73-74, 76-80, 82-83, 92, and 94-96 were rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,251,611 to Zehel et al. For the reasons set forth below, Applicants respectfully traverse these rejections.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Claim 67 recites an endoluminal apparatus comprising, inter alia, an elongated main body having first and second sections and a longitudinal axis, with the first section including a plurality of nested links and with substantially all adjacent links having a plurality of first pullwire lumens, and with the second section being steerable relative to the first section. The claim further recites a scope extended through at least a portion of a

lumen extending through the main body. The claim has been amended to recite that the main body comprises "a single tube." Support for this amendment is provided throughout the specification and drawings, such as, for example, at paragraphs 0069-0070, and at Figures 2A-B. Figures 2A-B are reproduced below, and show cross-sectional views of two embodiments of endoluminal tool deployment systems that include a shaft 20 that corresponds with the recited "main body":

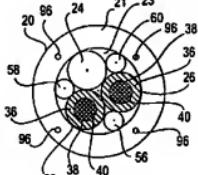


FIG 2A

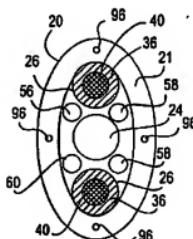


FIG 2B

The Zehel patent, on the other hand, describes a device that includes an inner flexible conduit 10 that is threaded through an outer flexible conduit or similar tube 11. (See Zehel, col. 4, lines 4-20). The inner conduit 10 and outer conduit 11 are separate members, with the inner conduit being slidably disposed and free to travel within the outer conduit 11. (Zehel, col. 4, lines 49-52). This feature is also illustrated in FIGS. 7-8 from the patent reproduced below:



FIG. 7

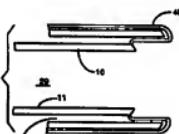


FIG. B

Turning to the rejection of claim 67, the Office Action identified the inner conduit 10 of the Zehel device as corresponding with the “first section” of the main body recited

in claim 67, and identified the Zehel outer conduit 11 as corresponding with the “second section” of the recited main body. However, claim 67 now recites that the main body – which includes both the “first section” and the “second section” – comprises “a single tube.” The inner conduit 10 and outer conduit 11 of the Zehel device do not constitute “a single tube” under a proper interpretation of the term as it is used in claim 67. For this reason, the Zehel device does not describe or suggest all of the features recited in claim 67, as amended.

Accordingly, there can be no anticipation of claim 67, as amended, by the Zehel patent. Nor can there be any anticipation by the Zehel patent of the claims dependent upon claim 67. Applicants request withdrawal of the rejections of those claims.

Turning next to claim 92, that claim recites an apparatus comprising, inter alia, a shaft having first and second sections and a longitudinal axis, with the first section including a plurality of first links and with substantially all adjacent links having a plurality of first pullwire lumens, and with at least one second section steering wire extending through substantially each of the links of the first and second sections. The claim further recites a scope extended through at least a portion of a lumen extending through the shaft. The claim has been amended to recite that the shaft comprises “a single tube.” Support for this amendment is the same as that discussed above.

As discussed above, the Zehel patent fails to teach or suggest a device meeting these limitations. Accordingly, for the same reasons set forth above, there can be no anticipation of claim 92. Applicants respectfully request withdrawal of the rejection of claim 92.

III. Rejection Under 35 U.S.C. § 103

Claim 84 was rejected under 35 U.S.C. § 103 as allegedly being unpatentable over the Zehel patent in view of U.S. Patent No. 3,897,775 to Furihata. For the reasons set forth below, Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) in view of a reference or combination of references, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references(s) must teach or suggest all of the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Finally, in determining the differences between the prior art and the claims, the question under 35 U.S.C § 103(a) is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

Claim 84 depends from claim 67 which, as discussed above, is patentable over the Zehel patent. The Furihata patent does not provide any of the disclosure missing from the Zehel patent. Accordingly, because neither of the cited patents teaches one or more limitations recited in the claims, the Office Action fails to establish a *prima facie* case of obviousness. Claim 84 contains patentable subject matter, and the rejection of the claim must be withdrawn.

Accordingly, Applicants request withdrawal of the rejections of the pending claims, and issuance of a notice of allowance.

Amendment and/or cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. Similarly, unless explicitly stated, nothing contained or not contained in this paper should be construed as an assent to any of the Examiner's stated grounds for rejecting the claims, including specifically the Examiner's characterization of the teachings of the cited art. Rather, the present amendments to the claims and Remarks are an attempt to expedite allowance and issuance of the currently pending claims.

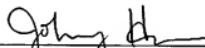
No new matter has been added.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the appropriate fee and/or petition is not filed herewith and the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with this filing to **Deposit Account No. 50-3973** referencing Attorney Docket No. **USGINZ00130**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,



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